

**REMARKS**

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-11 are now present in this application. Claims 1 and 11 are independent.

Reconsideration of this application is respectfully requested.

**Rejections Under 35 U.S.C. § 103**

The Office Action rejects claims 1-11 under 35 USC § 103(a) as unpatentable over U.S. Patent 6,774,8972 to Kawada et al (hereinafter, "Kawada"). This rejection is respectfully traversed.

The Office Action alleges that Kawada discloses all claimed features, except that Kawada does not "specifically teach the tape carrier packages connecting the driving boards and the electroluminescence panel in a planar state."

To remedy this admitted deficiency, the Office Action concludes that "it would have been obvious to minimize the size of the heat sink block to provide a display that is capable of being made having a small thickness."

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. Only when a *prima facie* case is made does the burden shift to the applicant to come forward to rebut such a case.



It is well settled that a rejection based on 35 U.S.C. § 103 must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995); In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Eritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim



must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

This rejection is improper for a number of reasons.

In the first place, the Office Action presents no objective factual evidence or reasoning to support this speculative conclusion. For that reason alone, it is improper. Moreover, no objective factual evidence that the claimed planar feature is found anywhere in Kawada is presented.

In the second place, plasma display panels, including that of Kawada, are normally of a relatively small thickness, and there is no objective factual evidence of record presented to show that there is a need to make Kawada’s display panel smaller than it is.

In the third place, even if it were shown (which it has not been) that it would be obvious to make Kawada’s plasma display panel to have a smaller thickness, there is no objective factual evidence of record presented to make it smaller by providing a claimed feature that is admittedly missing from Kawada, i.e., providing tape carrier packages connecting the driving circuit boards and the panel in a planar state.



Applicant respectfully submits that because Kawada does not disclose such a planar state feature, and because no objective factual evidence has been provided to show such a feature, the rejection is based on improper speculation and/or improper hindsight reconstruction of Applicant's claimed invention based solely on Applicant's disclosure.

In reply to the aforementioned arguments, which were presented in the Amendment filed on February 1, 2005, the Office Action states that Kawada discloses, in Fig. 4C, the tape carrier packages (21a') connecting the driving circuit boards 23 mounted on heat sink block 26 of the electroluminescence panel 11. However, Fig. 2, the prior art portion of Kawada, discloses the driving circuit board 23 mounted on the non-display substrate 11, wherein there is no heat sink block. The Office Action concludes, on the basis of the aforementioned premises, that it would have been obvious "to incorporate the driving circuit board is mounted on the non-display substrate without the heat sink block as taught by prior art Fig. 2, in order to reduce the thickness for the display."

Applicant respectfully disagrees with these arguments, including this conclusion of obviousness, for a number of reasons.

First, in Fig. 4C, Kawada's driving circuit board 23 is not provided on an electroluminescence panel substrate. Rather, it is shown as being attached to the bottom of heat sink 26, and is not located on either panel substrate 11 or 15.

Second, Kawada teaches away from using prior art electroluminescence panels of Fig. 2 because of a number of problems disclosed and discussed in column's 2 and 3 of Kawada. In other words, Kawada teaches away from modifying its Fig. 4C, because to do so would remove the benefits associated with Fig. 4C, which is disclosed by Kawada as an improvement over the



device of Fig. 2. In this regard, see Kawada's "Summary of the Invention" in columns 3 and 4 of Kawada, which points out that by using a heat sink, the efficiency of heat dissipation of prior art electroluminescence panels is "improved substantially" and the problem of heat dissipation of prior art electroluminescence panels is "successfully avoided." Thus, one of ordinary skill in the art would have no incentive to do away with Kawada's heat sink.

Third, Kawada discloses at least four separate versions of its invention, some of which are thinner than others. In fact, the three versions shown in Figs, 4A, 4B and 4C are all thinner than the version relied on in the rejection, i.e., the version shown in Fig. 4C. So, if one of ordinary skill in the art wants a thinner version of what the invention shown in Fig. 4 C, he or she can turn to Figs. 4A, 4B or 4C, none of which disclose or suggest the claimed invention.

Fourth, the Office Action never provides any detail of how its counter-intuitive proposed modification of Kawada, that removes the heat sink from Fig. 4C, would result in, or render obvious, the claimed invention which is a combination of features including tape carrier packages connecting the driving circuit boards and the electroluminescence "in a planar state." Actually, Fig. 4 shows a tape carrier package arrangement that has a U-shape, rather than a planar shape, and the Office Action does not explain what will motivate one of ordinary skill in the art to achieve the recited "planar state."

Because Kawada does not have the recited planar state and the Office Action fails to present any objective factual evidence that would motivate a skilled worker to modify Kawada to achieve the recited planar state, Applicant can only conclude that the rejection is based on impermissible speculation or impermissible hindsight reconstruction of the claimed invention based solely on Applicant's disclosure.



Accordingly, this rejection of claims 1-10 as unpatentable over Kawada is improper and should be withdrawn.

Reconsideration and withdrawal of this rejection is respectfully requested.

**Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

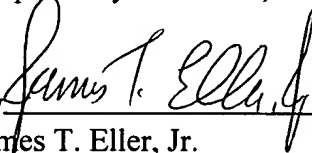
Prompt and favorable consideration of this Amendment is respectfully requested.



If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: September 22, 2005

Respectfully submitted,

By  \_\_\_\_\_

James T. Eller, Jr.

Registration No.: 39,538

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant

JTE/RJW/las/gf 